

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DENTSPLY SIRONA INC.,
Petitioner

v.

OSSEO IMAGING, LLC,
Patent Owner

Case IPR2025-00787

U.S. Patent No. 8,498,374

PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL

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EXHIBIT LIST

<i>Exhibit #</i>	<i>Description</i>
2001	Complaint in <i>Osseo Imaging, LLC v. Dentsply Sirona Inc. et al.</i> , Case No. 1:23-cv-07952-PKC-LB (E.D.N.Y.), filed October 25, 2023 (“District Court Action Complaint”)
2002	Court Order denying in part Planmeca USA, Inc. (“Planmeca”)’s Motion for Summary Judgment of No Infringement and Invalidity in View of Prior Art in <i>Osseo Imaging, LLC v. Planmeca USA Inc.</i> , 1-17-cv-01386 (D. Del. 2017) (the “Planmeca Action”) (“Planmeca Court Order”)
2003	Court’s Memorandum Opinion denying in part Planmeca’s Motion for Summary Judgment of No Infringement and Invalidity in View of Prior Art in the Planmeca Action (“Planmeca Memorandum Opinion”)
2004	Court’s Memorandum and Order on Planmeca’s renewed motions for judgment as a matter of law (“Planmeca JMOL Order”)
2005	Judgment in <i>Osseo Imaging, LLC v. Planmeca USA Inc.</i> , No. 2023-1627, 2024 WL 4031140 (Fed. Cir. Sep. 4, 2024) (“Judgment”)
2006	U.S. Patent No. 5,500,884 to Guenther <i>et al.</i> (“Guenther 884”)
2007	U.S. Patent No. 6,315,445 to Mazess <i>et al.</i> (“Mazess 445”)
2008	Opening Invalidity Expert Report of Dr. Norbert Pelc in the Planmeca Action (“Pelc Report”)
2009	Trial Transcript, Vol. 4, from the Planmeca Action dated August 25, 2022 (“Planmeca Trial Transcript”)
2010	Judgment Following Jury Verdict in the Planmeca Action (“Judgment Following Jury Verdict”)
2011	Patent Trial and Appeal Board’s Decision Granting Institution of IPR2020-00659 (“IPR659 Institution Decision”)
2012	Patent Trial and Appeal Board’s Termination Decision of IPR2020-00659 (“IPR659 Termination Decision”)
2013	U.S. Patent No. 5,784,429 to Arai (“Arai 429”)
2014	U.S. Patent No. 5,677,940 to Suzuki <i>et al.</i> (“Suzuki 940”)
2015	Court Order denying Carestream Dental LLC’s Motion to Dismiss in <i>Osseo Imaging, LLC v. Carestream Dental LLC</i> , Case No. 1:23-cv-03116-LMM (N.D. Ga) (“Carestream Dental Court Order”)

Case IPR2025-00787
Patent Owner's Request for Discretionary Denial

<i>Exhibit #</i>	<i>Description</i>
2016	Kass, Dani. (2025, June 10). Stewart's Newest Discretionary Denial Has Attys on Edge. <i>Law360</i> . https://www.law360.com/articles/2351596/print?section=ip .

Patent Owner Osseo Imaging, LLC (“Osseo” or “Patent Owner”) respectfully requests that the Director deny institution of the Petition for *Inter Partes* Review of U.S. Patent No. 8,498,374 (Case IPR2025-00787) filed by Dentsply Sirona Inc. (“Dentsply” or “Petitioner”) on March 26, 2025.

I. INTRODUCTION

Petitioner filed three petitions for *inter partes* review against the Osseo Patents.¹ In this Case IPR2025-00787, Petitioner challenges claims 1-24 (the “challenged claims”) of the ’374 Patent, entitled “Dental and Orthopedic Densitometry Modeling System and Method.” *See* EX1001. Osseo is requesting that this IPR petition as well as the other two petitions be discretionarily denied by the Director as an inefficient use of the Board’s time and resources; the Osseo Patents have already been confirmed to be valid several times over substantially the same arguments presented here, the issues to be decided here are very complex, no public interest justifies the Board spending the necessary time and resources, and Petitioner has known about its alleged infringement of the Osseo Patents for over a decade and is first now taking action to have their validity reconsidered.

¹ U.S. Patent Nos. 6,381,301, 6,944,262 and 8,498,374 (the “’301 Patent,” the “’262 Patent,” and the “’374 Patent,” respectively) (the ’301 Patent, ’262 Patent, and ’374 Patent, collectively, the “Osseo Patents”). *See* EX1001, EX1002, and EX1003.

The Osseo Patents are the subject of a pending district court litigation involving Petitioner, *Osseo Imaging, LLC v. Dentsply Sirona Inc. et al.*, Case No. 1:23-cv-07952-PKC-LB (E.D.N.Y.), filed October 25, 2023 (the “District Court Action”).² There is a pending Motion to Dismiss that was fully briefed as of November 8, 2024 in the District Court Action³, and no response to the complaint is currently due.

The validity of the '374 Patent is not a novel issue. Rather, the '374 Patent has been unsuccessfully challenged on numerous occasions in various forums. Each and every time, the challenged claims of the '374 Patent were confirmed as valid, including by the Federal Circuit. Although some of the prior art references here are nominally different than those asserted in the prior challenges, the basic theories for invalidity – that it would have been obvious to combine art allegedly showing tomographic imaging for dental structures with art showing the use of bone density data – are the same. Either the same prior art or substantially the same prior art as that asserted by Petitioner was considered in the prior proceedings as well as during

² The District Court Action has not been stayed pending the IPR Petition. Cf. *Tessell, Inc. v. Nutanix, Inc.*, IPR2025-00322, Paper 14 at 2 (P.T.A.B. June 12, 2025) (“a stay in the parallel district court proceeding weighs against discretionary denial...”).

³ Petitioner's Motion to Dismiss in the District Court Action seeks to invalidate the Osseo Patents under 35 U.S.C. § 101. An identical Motion to Dismiss was filed and subsequently denied by the Court in *Osseo Imaging, LLC v. Carestream Dental LLC*, Case No. 1:23-cv-03116-LMM (N.D. Ga). See EX2015.

prosecution of the '374 Patent. Institution of the Petition would be a lengthy and inefficient use of the Board's time and resources only to arrive at the same conclusion as the Federal Circuit along with Federal Judges, a jury, and the patent examiner that considered every other prior challenge.

This case is very complex. The Board will need to resolve many difficult legal and technical issues including the state of the art over 25 years ago when the parent of the '374 Patent, *i.e.*, the '301 Patent, was filed. The complexity of this case can be readily seen by Petitioner's extensive reliance on expert testimony. The expert declaration submitted by Petitioner's expert, Dr. Milan Sonka, is 287 pages long and is cited to approximately 130 times throughout the Petition. Osseo's expert, Dr. Omid Kia, has provided extensive expert declarations and testimony in the prior proceedings and will of course be providing one or more additional declarations in this and the two related proceedings, all of which dispute and contradict Dr. Sonka's opinions and conclusions. That the Board will need to wade into this morass of complex factual and technical issues strongly suggests that this dispute would be better resolved in the District Court Action rather than in this IPR proceeding.

At the same time, there are *no* compelling economic or public health interests to warrant institution of the Petition. The '374 Patent expired over *five and a half years* ago, in December, 2019. Osseo could therefore not obtain injunctive relief now, and so there is no risk the public will be denied access to Petitioner's dental

imaging systems. The only issue at stake in the District Court Action is whether Petitioner will owe Osseo royalties for its sales of allegedly infringing systems over a defined damages period that ended when the '374 Patent expired. There are no other actions pending involving the Osseo Patents, and every other case involving the Osseo Patents was resolved through a judgment or resolution between the parties involved. Indeed, Petitioner is the sole hold-out in reaching resolution with Osseo, and while it is certainly allowed to contest the issues, it should not tie up substantial resources of the Board just to resolve this private dispute with Osseo over money.

Finally, Petitioner was aware of the Osseo Patents since at least 2009, and knew Osseo asserted it was infringing the Osseo Patents since at least 2014, but in all that time never pursued a validity challenge against any of the Osseo Patents. *See* EX2001 at 6-7 .

For at least these reasons, Osseo respectfully requests that the Director exercise discretion under 35 U.S.C. § 314(a) to deny institution of the Petition.

II. THE MARCH 26, 2025 ACTING DIRECTOR'S MEMORANDUM

Pursuant to the March 26, 2025 Acting Director's Memorandum (the "Memo"), which outlines "Interim Processes for PTAB Workload Management" including a bifurcated approach for considering discretionary denial, Patent Owner respectfully submits that the Director should deny institution of the Petition. Consistent with the FAQs for Interim Processes for PTAB Workload Management

(the "FAQs"), this filing is being made within two months of April 16, 2025, the date on which the PTAB entered a Notice of Filing Date Accorded to Petition (Paper 4).

35 U.S.C. § 314(a) provides a discretionary mechanism for the Director to deny institution of a Petition just like the one filed in this proceeding. The Supreme Court has confirmed that "[t]he agency's decision to deny a petition is a matter committed to the Patent Office's discretion." *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016).

The Memo outlines relevant considerations for exercising discretionary denial under § 314(a), including:

- Whether the PTAB or another forum has already adjudicated the validity or patentability of the challenged patent claims;
- Whether there have been changes in the law or new judicial precedent issued since issuance of the claims that may affect patentability;
- The strength of the unpatentability challenge;
- The extent of the petition's reliance on expert testimony;
- Settled expectations of the parties, such as the length of time the claims have been in force;
- Compelling economic, public health, or national security interests; and
- Any other considerations bearing on the Director's discretion.

Memo at 2-3.

As explained more fully below, denial of the Petition is warranted under 35 U.S.C. § 314(a) in view of the above considerations. The fact that the challenged claims have already been litigated multiple times and their validity upheld against the same or substantially similar references as those currently asserted by Petitioner is dispositive. Thus, the Petition is ripe for discretionary denial considering the Memo's aim to "improve PTAB efficiency, maintain PTAB capacity to conduct AIA proceedings,...and promote consistent application of discretionary considerations in the institution of AIA proceedings." Memo at 3. Furthermore, Osseo disputes that Petitioner can meet its burden to establish that the Board should institute *inter partes* review. Some of the reasons for that are highlighted below, with additional details to be provided in Patent Owner's Preliminary Response.

III. DISCRETIONARY FACTORS FAVOR DENIAL OF INSTITUTION

For each of the reasons detailed herein, the discretionary factors set forth in the Memo favor denial of institution of the Petition.

Osseo respectfully notes that any opposition brief filed by Petitioner in response hereto should not be used as an opportunity to address the deficiencies of the Petition, of which there are many. If anything, any attempt by Petitioner to provide additional evidence or arguments should be viewed as an admission by

Petitioner of the deficiencies of the Petition and should weigh further in favor of denying institution.

A. THE VALIDITY OF THE CHALLENGED CLAIMS HAS ALREADY BEEN ADJUDICATED AND CONFIRMED

1. The '374 Patent Was Repeatedly Upheld as Valid By Other Tribunals

In Case No. 17-cv-01386-JFB, the '374 Patent was upheld as valid and nonobvious over prior art during three separate stages of the case – first when Planmeca's Motion for Summary Judgment of No Infringement and Invalidity in View of Prior Art was denied, second when the jury found that Planmeca had failed to prove by clear and convincing evidence that the '374 Patent was invalid, and third when Planmeca's post-trial motions for judgment as a matter of law were denied. *See* EX2002; EX2003; EX2004. This verdict was then affirmed by the Federal Circuit in a precedential decision dated September 4, 2024. *See* EX2005. The Federal Circuit affirmed that substantial evidence supports the jury's verdict of non-obviousness of the challenged patent claims of the '374 Patent, finding:

Substantial evidence supports the jury's findings necessary to support the verdict that the Asserted Patents are not invalid as obvious. First, Dr. Kia disputed Dr. Pelc's conclusions regarding obviousness. J.A. 5056 at 1127:3– 22. Dr. Kia then testified on the differences between tomosynthesis and computed tomography. J.A. 5057–60 at 1128:10– 1131:13. This discussion served as a backdrop against which Dr. Kia explained that densitometry, or bone density data, and tomosynthesis are incompatible with each other because tomosynthesis scans can produce blurry anatomical images. J.A. 5060–63 at 1131:14–1134:6.

Based on this entire discussion, Dr. Kia concluded it would not have been obvious to a person of ordinary skill in the art to combine the tomosynthesis concept in Guenther with the densitometry concepts in Mazess and Fontevraud. *See* J.A. 5056 at 1127:3–22 (noting “one of ordinary skill in the art would not look to bone general density for a solution for a problem related to tomosynthesis”); J.A. 5068 at 1139:9–18; J.A. 5064–69 at 1135:13–1140:13. Thus, the jury heard evidence demonstrating that it would not have been obvious to a skilled artisan to combine the prior art references. The jury could reasonably rely on such evidence to find that Planmeca did not meet its burden to establish by clear and convincing evidence that the asserted claims of the Asserted Patents are invalid for obviousness. Accordingly, we affirm the district court’s denial of JMOL.

Id. at *17-18.

In support of its invalidity arguments, Planmeca relied on the testimony of its expert, Dr. Norbert Pelc, whose patent documents Petitioner now asserts as prior art.⁴ In his invalidity opinion, Dr. Pelc alleged, among other things, that the ’374 Patent was anticipated and/or obvious in view of U.S. Patent No. 5,214,686 to Webber (“Webber 686”), U.S. Patent No. 5,500,884 to Guenther *et al.* (“Guenther 884”), U.S. Patent No. 6,315,445 to Mazess *et al.* (“Mazess 445”), U.S. Patent No. 6,898,302 to Brummer (“Brummer 302”), and U.S. Patent No. RE 36,162 to Bisek *et al.* (“Bisek 162”). *See* EX2006; EX2007; *see also generally* EX2008. Planmeca unequivocally lost on each ground – a fact that Petitioner fails to even mention. Indeed, Petitioner attempts to significantly downplay the Planmeca Action, only

⁴ Dr. Pelc is a named inventor of International Publication No. WO 94/10908 (“Pelc 908”) and U.S. Patent No. 5,533,080 (“Pelc 080”). *See* EX1015; EX1018.

referencing it in the context of claim construction, and entirely neglects to acknowledge its outcome, including the upholding of the '374 Patent's validity. *See* Petition at 20. This is likely because Petitioner's arguments for invalidity here are essentially the same as those asserted by Planmeca and rely on prior art that is substantially the same as the art relied upon in the Planmeca Action.

2. Arguments that Substantially Overlap with Petitioner's Were Already Addressed and Overcome in the Planmeca Action and Have Significant Weaknesses

The invalidity arguments in the Petition "overlap substantially with those" in the Planmeca Action. *See E-One, Inc. v. OshKosh Corp.*, IPR2019-00161, Paper 16 at 8 (P.T.A.B. May 15, 2019). Petitioner does not dispute the claim constructions from the Planmeca Action and presents prior art and arguments here that "essentially duplicate what has been...litigated" in the Planmeca Action, leaving little point to the Board having to investigate and address the same issues again. *Id.* at 7.

Petitioner relies for its primary references on U.S. Patent No. 6,118,842 ("Arai 842") and Pelc 908. *See* EX1013; EX1015. Contrary to Petitioner's arguments, and as will be further spelled out in Patent Owner's Preliminary Response, the computed tomography ("CT") system used to generate tomographic models in Arai 842 or Pelc 908 does not provide information regarding bone density as required by the challenged claims. *See* Petition at 34-35 (citing EX1007 at ¶¶ 70, 92-93, 227-229). Neither reference mentions bone density or densitometry at all.

Recognizing this obvious deficiency with its prior art, Petitioner argues that the bone density data is somehow either inherently there in the opinion of their expert or is taught by other art that can be combined with Arai 842 or Pelc 908. *See* Petition at 35-36 (citing EX1007 at ¶¶ 181-185, 231). Significantly, Dr. Pelc himself (an inventor of Pelc 908), when serving as Planmeca's expert, testified at trial that CT scans alone *do not* measure quantitative bone density. *See* EX2009 at 789:6-18 (Dr. Pelc explaining how pioneers in the field of quantitative computed tomography ("QCT") "realized that CT alone was not able to quantitatively measure or compute bone density by itself."); *id.* at 921:13-20 (Dr. Pelc explaining why someone imaging a skeleton using CT alone would not be able to assess bone density). As such, the very testimony of the inventor on one of Petitioner's primary references has already undermined Petitioner's main argument. At the very least, Pelc's testimony in the Planmeca Action shows that this very issue has already been considered and decided.

Indeed, Petitioner's strategy of combining Arai 842 and/or Pelc 908 with either their expert's assertion that they inherently disclose bone density data or with another reference allegedly showing densitometry is an exact repeat of the positions argued in the Planmeca Action. In that action Planmeca repeatedly tried – during summary judgment, the jury trial, the post-trial motions, and on appeal to the Federal Circuit – *but failed* to show that its primary references like Guenther 884, which allegedly taught tomographic imaging, either inherently disclosed a model with

quantitative bone density or would have been obvious to combine with other references that allegedly taught densitometry. *See* EX2002; EX2003; EX2004; EX2005; EX2010. The same arguments being presented here by Petitioner using Arai 842 and Pelc 908 instead of Guenther 884 should and will fail for the same reasons – that it would, in fact, *not have been obvious* to one of ordinary skill in the art to make such a combination in 1999, the priority date of the '374 Patent. For the purposes of Petitioner's invalidity arguments, Arai 842 and Pelc 908 represent the same disclosures as Guenther 884, just under a different name.

One of the combinations Petitioner tries to make is Arai 842 as its primary reference combined with Cann, *et al.*, "Precise Measurement of Vertebral Mineral Content Using Computed Tomography," *Journal of Computer Assisted Tomographs*, 4(4), 493–500 (August 1980) ("Cann 1980") in support of its obviousness arguments. *See* Petition at 33-56; EX1014. Just as the Federal Circuit affirmed a finding that it would not have been obvious to a person of ordinary skill in the art to combine the tomosynthesis concept in Guenther 884 with the densitometry concepts in Mazess 445, a combination of the CT system of Arai 842 with the densitometry measurements allegedly disclosed in Cann 1980 would not be obvious either. *See* EX2005 at *17-18.

Perhaps more importantly, Petitioner's use of Cann 1980 should fail for another reason – it's *the same reference* that was already raised and overcome in the

Planmeca Action. Indeed, Cann 1980 was used in the Planmeca Action *for the same purpose* that Petitioner is raising it here, *i.e.*, as allegedly discussing densitometry as required by the challenged claims. EX2008 at ¶¶ 135, 194; *see also* EX2009 at 918:22-24 (“Q. Okay. And this Cann article you say teaches bone densitometry and quantitative computed tomography? A. Yes.”).

Moreover, Petitioner mischaracterizes Arai 842 in a critical way. Petitioner alleges that Arai 842 teaches use of CT to generate a tomographic model. *See* Petition at 34. This is not correct. Arai 842 discusses two imaging modes which *never operate simultaneously* – a CT mode and a panoramic tomographic mode. *See* EX1013 at 2:36-49; *id.* at Abstract. In Arai 842, “the imaging mode is selected by the mode switching means, whereby the selected X-ray imaging can be conducted.” *Id.* at 2:47-49. Petitioner tries to bury this fact, erroneously stating that “Arai 842 teaches a system for tomographically modeling dental structure densitometry.” Petition at 34. Arai 842 either creates a CT image in the CT mode *or* a panoramic tomographic image in the panorama mode – it does not disclose creating a tomographic model using CT, and certainly never discloses a tomographic model showing dental structure densitometry as required by the challenged claims. *See* EX1013 at 2:36-49.

Furthermore, Pelc 908 is very similar to Mazess 445 which Planmeca asserted as prior art in the Planmeca Action – Richard B. Mazess is a named inventor on both,

and both of these patents were assigned to Lunar Corporation. Once again, Petitioner attempts to assert prior art that is close to or identical to the prior art already asserted and defeated in the Planmeca Action. Petitioner's invalidity arguments amount to nothing more than a shell game – a mere reshuffling of names and references that have already been adjudicated and overcome.

3. Dr. Pelc Himself Admitted That None of His Patents Relate to Dental Imaging

The named inventor of Pelc 908 and Pelc 080, Dr. Pelc himself, admitted at trial in the Planmeca Action that none of his patents or articles are related to dental imaging, and that he does not have any expertise in that field. *See* EX2009 at 903:2-9 (“Q. During your -- any of your degrees, did you take any courses focused on dental imaging? A. No. Q. What about dental care, dentistry, anything like that? A. No.”); *id.* at 903:23-25 (“Q. Thank you, did you do any work in designing of machines focused on dental imaging? A. No.”); 906:6-12 (“Q. Were any of those articles specifically focused on dental imaging? A. No. Q. I see you have listed here some courses that you have taught, x-ray computed tomography, so forth. Did you ever teach any courses on dental imaging? A. No.”); 906:17-907:2 (“Q. You're an inventor on 95 patents? A. That's correct. **Q. Were any of those patents specifically focused on improvement in dental imaging? A. No.** Q. If I were to do a search, say the word teeth, you know, in any field of your 95 patents, how many patents

would come up? A. I have no idea. Q. Would it surprise you that the answer is 0? A. No.”) (emphasis added).

Notably, the fact that Dr. Pelc was the expert in the Planmeca Action and he himself did not assert his patent (*i.e.*, Pelc 908, cited by Petitioner) during expert disclosures and testimony speaks volumes as to the weakness of Petitioner's invalidity arguments in the Petition.

4. The Board Did Not Have the Benefit of Referring to Almost Five Years of Litigation Upholding the Challenged Claims When the '659 IPR Was Instituted

As Petitioner has pointed out, the '374 Patent was subject to a prior IPR, Case IPR2020-00659 (the "'659 IPR), which was filed by Kavo Dental Technologies, LLC ("Kavo") and instituted on June 10, 2020. *See* EX2011. Petitioner relies on the same prior art and substantially the same grounds that the Board previously concluded warranted institution in the '659 IPR. Petitioner does not explicitly rely on any changes in the law or new judicial precedent since issuance of the challenged claims that may affect patentability. *See generally* Petition. The Board's institution of the '659 IPR has little relevance to whether it should consider or will institute the instant IPR proceeding.

The fact that the Board instituted the '659 IPR is not an indication of the merits of that case or of the instant case. Osseo did not present any substantive arguments in the Patent Owner Preliminary Response in the '659 IPR. Instead, Osseo merely

argued for discretionary denial of institution in view of the upcoming trial in the Planmeca Action. *See* EX2011 at 11 (“Patent Owner argues we should exercise discretion under 35 U.S.C. § 314(a) and deny institution based on the trial scheduled for October 2020 in the Planmeca proceeding.”); 26-27 (“Patent Owner does not dispute Petitioner’s contentions at this time.”).

The ’659 IPR was then terminated as a result of settlement; as such, the Board did not reach a Final Written Decision. *See* EX2012. Since then, almost five years of litigation regarding the challenged claims have repeatedly proven their validity. At the time of the ’659 IPR, the Board did not have the benefit of referring to the outcome of the Planmeca Action or the Federal Circuit decision affirming the verdict in the Planmeca Action. Moreover, in view of its termination before a Final Written Decision was issued, Osseo never substantively responded to the petition in the ’659 IPR.

Since the Board’s decision to institute the ’659 IPR was made without having any evidence presented by Osseo or without the benefit of the testimony and findings of the Planmeca Action, it does not at all follow that this Board will or should reach the same conclusion.

In sum, the validity of the ’374 Patent has been considered not once, not twice, but *three times* – twice by two judges as well as by a jury. The myriad weaknesses in Petitioner’s unpatentability challenge, including a few of which were spelled out

above, further favors utilizing the discretionary power of the Director to deny institution.

B. SUBSTANTIALLY THE SAME PRIOR ART WAS PREVIOUSLY PRESENTED TO THE OFFICE

Not only are the prior art and invalidity arguments relied upon by Petitioner substantially the same as those in the Planmeca Action, they are also substantially the same as prior art considered during prosecution of the Osseo Patents, providing an additional reason for the Director to exercise discretion to deny this Petition.

“Section 325(d) provides that the Director may elect not to institute a proceeding if the challenge to the patent is based on matters previously presented to the [United States Patent and Trademark] Office” (the “Office”). *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, No. IPR2019-01469, 2020 WL 740292, at *2–3 (P.T.A.B. Feb. 13, 2020). 35 U.S.C. § 325(d) states, in pertinent part, “[i]n determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31, the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.” *Advanced Bionics, LLC v. GmbH* at *2-3.

Under § 325(d), the prior art and arguments must have been previously presented to the Office during proceedings pertaining to the challenged patent. *Id.* at *3. Previously presented art includes art made of record by the Examiner, and art

provided to the Office by an applicant, such as on an Information Disclosure Statement, in the prosecution history of the challenged patent. *Id.* The proceedings in which the art was previously presented include, for example, examination of the underlying patent application. *Id.*

Applicant Osseo filed an Information Disclosure Statement (the “IDS”) on September 14, 2012, when the application leading to the '374 Patent was filed. See EX1004 at 39. The IDS listed, amongst other patents, U.S. Patent No. 5,784,429 to Yoshinori Arai, entitled “Dental Panoramic X-ray Imaging Apparatus” (“Arai 429”), and U.S. Patent No. 5,677,940 to Masakazu Suzuki, Keisuke Mori, and Akifumi Tachibana, entitled “Digital X-ray Imaging Apparatus” (“Suzuki 940”). *See id.*; *see also* EX2013; EX2014. Masakazu Suzuki, Keisuke Mori, and Akifumi Tachibana are named inventors of Arai 842, which is cited by Petitioner in the present case. *See* EX1013. Pelc 080, which is also cited by Petitioner in the present case, was also listed in the IDS. *See* EX1004 at 48; EX1018.

The disclosures of Arai 842, Arai 429, and Suzuki 940 are all directed to panoramic tomographic imaging (and not tomographically modeling dental structure densitometry as taught by the '374 Patent) and none of these references even mention densitometry. *See* EX1013 at Abstract, 2:36-49; EX2013 at Abstract; EX2014 at 1:5-9. The fact that substantially the same prior art was made of record and

considered by the Office during prosecution of the '374 Patent further supports a denial of the Petition as an inefficient use of the Board's time and resources.

C. NO COMPELLING ECONOMIC OR PUBLIC HEALTH INTERESTS REMAIN FOLLOWING EXPIRATION OF THE '374 PATENT

The '374 Patent expired over five and a half years ago, on December 1, 2019. Osseo could not now obtain an injunction preventing Petitioner from selling its allegedly infringing dental imaging systems. Petitioner would not even need to consider making any changes to its dental imaging systems to avoid infringement since there could not be any ongoing claims of infringement. As such, the public interest in having access to these systems is not in jeopardy.

Indeed, the only issue that remains to be determined is whether Petitioner will need to pay Osseo royalties for its sales of allegedly infringing systems from five to eight years ago. *See* EX2001 at 5 (“The ‘Damages Period’ is defined as October 25, 2017 through August 9, 2020.”). There is no public interest in that issue.

In addition, there are no other pending lawsuits involving the '374 Patent. All other cases against companies selling similar dental imaging systems, including Planmeca, Kavvo, and Carestream Dental LLC⁵, have either been resolved through

⁵ *Osseo Imaging, LLC v. Carestream Dental LLC*, Case No. 1:23-cv-03116-LMM (N.D. Ga), filed July 14, 2023. The parties opted to terminate the action following the Court's dismissal of Carestream Dental LLC's Motion to Dismiss. *See* EX2015.

judgment or otherwise settled. Petitioner is the lone remaining adverse party, and with less than six months to go before expiration of the six-year lookback period, it appears nearly certain that no other companies will have an interest in the outcome of these proceedings.

As such, there are no compelling economic or public interest issues at stake to compel institution of the Petition. As recently stated by Director Stewart, the Board's resources should be used to "take up important cases" and the Board does not "need to be an on-demand extension of purely private disputes." *See* EX2016.

D. PETITIONER'S EXTENSIVE RELIANCE ON EXPERT TESTIMONY FAVORS DENIAL

As the discussion above may make clear, this IPR would be complex and difficult. One need look no further than Petitioner's extensive reliance on the declaration of their expert, Dr. Sonka. In the absence of compelling prior art, Petitioner heavily relies on Dr. Sonka's declaration, which itself is 287 pages long, citing to it approximately *130 times* over the course of the Petition. *See generally* Petition; EX1007. Yet Dr. Sonka's declaration adds little, if any, value as it frequently relies on conclusory statements, unsubstantiated arguments, and repeating/rewording the contents of the Petition. Such conclusory analysis is not helpful to the trier of fact, and Petitioner's heavy reliance on Dr. Sonka's opinion is another reason that the Petition should be discretionarily denied.

The FAQs explain that “[w]hile the Board may consider expert testimony, as a matter of efficiency, extensive reliance on expert testimony and/or reasonable disputes between experts on dispositive issues may suggest that the questions are better resolved in an Article III court.” In addition to Dr. Sonka’s report and opinions, Osseo will be presenting contrary expert opinions from Dr. Kia. Dr. Kia has provided extensive expert declarations and testimony in the Planmeca Action and will do so again in this and the two related proceedings. *See* EX2005. Denial of the Petition is warranted in order to avoid having the Board resolve the disputes about these complex issues between the two experts.

Even the necessary level of skill in the art alleged by Petitioner highlights how difficult and complicated the issues in this IPR would be. *See* Petition at 19-20 (Petitioner stating that a person of ordinary skill in the art “would include a person with an advanced medical degree, such as an MD, DDS, or DMD if also combined with an undergraduate degree in Computer Science, Engineering, Medical Physics, Physics, or a related field, and/or an advanced degree in Medical Physics, Physics, or a related field, and at least three years of experience in using and/or designing medical imaging devices, including CT imaging systems and/or densitometry imaging systems, with education substituting for experience and *vice versa*.”).

A case such as this – one which promises experts battling on endless complex technical issues – would be an extremely inefficient use of the Board’s resources.

This is exactly the kind of case that is best left to a district court. Therefore, the Petition should be denied under 35 U.S.C. § 314(a) for this additional reason.

E. THE LENGTH OF TIME THE CHALLENGED CLAIMS HAVE BEEN IN FORCE, AND THAT PETITIONER WAS AWARE OF THE THEM, FAVOR DENIAL

The '374 Patent has been in force since July 13, 2013. Petitioner was aware of the Osseo Patents in 2009 and Osseo's assertions that they were being infringed by Petitioner's dental imaging systems since as early as June 2014, when Osseo's prior counsel sent Petitioner the first of several letters. *See* EX2001 at 7. Petitioner thus had long-standing knowledge of the Osseo Patents and failed to seek review of them earlier, either through reexamination requests, a declaratory judgment action, or other post grant proceedings. This factor favors denial. *See iRhythm Technologies, Inc. v. Welch Allyn, Inc.*, IPR2025-00363, Paper 10 at 3 (P.T.A.B. June 6, 2025).

IV. CONCLUSION

For at least the reasons noted above, the Director should exercise its discretion under Section 314(a) and decline to institute *inter partes* review of the '374 Patent.

Case IPR2025-00787
Patent Owner's Request for Discretionary Denial

Dated: June 16, 2025

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CERTIFICATE OF COMPLIANCE

The undersigned certifies this document complies with the type-volume limitation of 37 C.F.R. § 42.24(b). The PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL contains 5,251 words, as calculated by Microsoft Word (not including the portions exempted by 37 C.F.R. § 42.24).

Dated: June 16, 2025

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e)(4) and 42.205(b), the undersigned certifies that on June 16, 2025, a true and correct copy of the PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL was served by filing this document through the PTAB E2E portal and via email to the following counsel for the Petitioner:

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